



UNITED STATES PATENT AND TRADEMARK OFFICE

cll

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,467	03/30/2004	Anna Marie Aguinaldo	A-71431-4	7268

7590 06/27/2006

Robin M. Silva, Esq.
Dorsey & Whitney LLP
Intellectual Property Department
Four Embarcadero Center, Suite 3400
San Francisco, CA 94111-4187

EXAMINER

HISSONG, BRUCE D

ART UNIT PAPER NUMBER

1646

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Election/Restrictions

A. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a variant type I IFN- β , classified in class 424, subclass 85.6.
- II. Claims 6-10, drawn to a variant type I IFN- α , classified in class 424, subclass 85.7.
- III. Claims 11-15, drawn to a variant type I IFN- κ , classified in class 424, subclass 85.4.

B. The inventions are distinct, each from the other because of the following reasons:

Inventions I - III are independent and distinct inventions, each from the other, because they are products that possess characteristic differences in structure and function, and each has a distinct and independent utility. In the instant case, the three interferons encompassed by the three groups are made by different cell types, have different amino acid sequences, and have different biological functions.

C. Additionally, groups I - III, are subject to further restriction. It is noted that the claims are drawn to examination of at least one of a number of structurally distinct interferon variants characterized by at least one modification at various amino acid positions. In order to be fully responsive, applicant is required to further elect a specific variant interferon sequence, identified by the location and nature of the modification, and by SEQ ID NO. This is NOT an election of species. The claimed polypeptides are structurally distinct chemical compounds, and are thus deemed to normally constitute independent and distinct inventions within the meaning of 35

Art Unit: 1646

U.S.C. 121. Absent evidence to the contrary, each such polypeptide is presumed to represent an independent and distinct invention, subject to restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141. By statute "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." 35 U.S.C. 121. Pursuant to this statute, the rules provide that "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant....to elect that invention to which his claim shall be restricted." 37 CFR 1.142(a). See also 37 CFR 1.141(a). It is noted that search more than one of the claimed patentably distinct polypeptides represents a serious burden for the office.

D. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

E. Applicant is also advised that the reply to this requirement, **to be complete**, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

F. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


G. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce D. Hissong, Ph.D., whose telephone number is (571) 272-3324. The examiner can normally be reached M-F from 8:30am - 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, Ph.D., can be

Art Unit: 1646

reached at (571) 272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BDH
Art Unit 1646


ROBERT S. LANDSMAN, PH.D
PRIMARY EXAMINER